REMARKS

The objection to the Declaration is noted and reconsideration is requested. The Declaration clearly sets forth the date of the filing of the utility application in the heading (immediately below Application No. 09/976,674) as October 12, 2001. This information is repeated in the middle of page 1, except the date is identified merely as October 12. Inasmuch as all of the inventors signed in 2001, it is believed that the paper as filed adequately identifies the specification in question, from the standpoint of specifying the serial number that was assigned and reciting the month and day of its filing in two separate places. Accordingly, reconsideration of the objection to the Declaration is requested; and upon reconsideration, it is hoped that the objection will be withdrawn. However, a second supplemental Declaration further referring to the claims that were part of the Amendment filed on May 21, 2003, has been executed by the inventors and is being filed along with this paper.

Following receipt of this Office Action, a telephone interview was held with Examiner Walicka and a supervisory Examiner, and subsequent to that telephone conference, a voice mail message was received indicating that the finality of the rejection would be withdrawn so that Applicant would have the opportunity to present arguments with regard to the new rejection based upon a patent to Hyseq, Inc. which issued on May 27, 2003. This withdrawal of the finality was then formalized in a paper mailed November 10, 2003.

In the very first Office Action, the Examiner asked for a five-way restriction requirement in which the alternative splice variants were included along with the isolated nucleic acid of claim 1 in Group I; Group I was elected. The Examiner now reiterates, in the latest restriction requirement on page 2 of the Office Action, that: "Applicant elected in Paper No. 7, filed on November 4, 2002, to prosecute claims 1 - 6 and 8 - 13 directed to DNA of SEQ ID NO: 4....".

Claim 6 that was elected read as follows:

6. The isolated nucleic acid of claim 1 which is an alternative splice variant of one of SEQ ID NOS: 2, 4 and 6.

Claims 32, 33, and 34, which presently stand withdrawn, recite, in varying degrees of specificity, alternative splice variants of SEQ ID NO: 4. Thus, it is submitted that these claims are not "independent or distinct from the invention originally elected"; they are clearly a part of the invention originally elected.

The Examiner apparently now takes the position that despite the original restriction and election, a further nine-way restriction requirement from among those claims contained in original Group I is now appropriate. This further restriction requirement under the present circumstances is respectfully traversed, along with the Examiner's coincidental withdrawal of claims 32, 33, and 34. Reconsideration is requested.

All of these nucleic acids function as enzymes; all would have prolyl oligopeptidase activity. All are alternative splice variants of the nucleic acid SEQ. ID NO: 4 which was elected. In the response filed on May 20, 2003, Applicant listed five U.S. patents that had recently issued, all of which contain claims to splice variants of protein-encoding nucleotide sequences.

The examiner states, in the current restriction explanation, that the elected nucleic acid encodes a protein that would have the activity of a di-peptidyl peptidase; claim 33 specifies alternative spice variants of the elected nucleic acid encoding polypeptides that similarly exhibit prolyl oligopeptidase activity. Thus, these are not divergent molecules having different functions as the examiner states; they are all part of a common inventive concept based upon the DNA sequence of SEQ. ID NO: 4. Accordingly, Applicant strongly submits that it is error to now require further restriction between alternative splice variants in this situation.

In the Press Release dated October 6, 2003, the USPTO announced an action plan targeted to respond to customer needs for biotech applications entitled the TC 1600 restriction practice action plan. Point one of this five point plan promises to publish examples of sets of claims that will be examined together regardless of whether they can be otherwise restricted because the search and examination of the claims have been determined not to present a serious burden on the office. Unfortunately, this plan and such published examples are yet to be implemented; however, the spirit of the plan was discussed briefly by Robert Sphar in a meeting with the San Diego Intellectual Law Property Law Association. He said it was to

address the unique needs of the biotech community to allow such claims to be examined in the same application when there was truly no additional burden on the office. Such is submitted to be the case here. Hopefully, this will be one of the situations covered in these examples, which are presumably on the drawing board at the USPTO.

It is respectfully requested that this further restriction be reconsidered and withdrawn and that the three claims that were held to be withdrawn be instead examined.

With respect to the Examiner's rejections under 35 U.S.C. §112, second paragraph, amendments have been made as generally suggested to claim 22, claim 24, claim 26 and claim 35. Claim 39 has been rewritten as new claim 44, and claim 27 has been amended in a manner which should obviate the Examiner's objections. With respect to claims 29 and 41, Applicant has deleted the word "mature" which the Examiner found objectionable and instead defines the protein which is coded for as one which exhibits prolyl oligopeptidase activity. Thus, it is believed that all of the Section 112 rejections should now have been cured.

The new rejection of claims 29, 30, 31 and 41-43, under 35 USC §112, first paragraph, as failing to comply with the written description requirement, is respectfully traversed. It is submitted that an investigator having the ordinary skill in the art, when presented with nucleotide SEQ ID NO: 4, would be able to routinely use this nucleic acid sequence to produce a mature protein having prolyl oligopeptidase activity. However, it is believed that the point has been rendered moot by the amendment of these claims to remove the word "mature" which the examiner finds objectionable; see appropriate amendments to claims 29, 30 and 41-43. In view of these amendments to the claims, it is believed that reconsideration and withdrawal of the rejection under §112 are appropriate.

After withdrawing the earlier rejection of the claims under 35 USC §102, the Examiner entered a new rejection based upon U.S. Patent No. 6,569,662 to Tang et al., which recently issued earlier this year on May 27, 2003. The patent contains over 1100 sequences, with the sequence listing being available only in electronic form from the USPTO website. Reference was made in the rejection to SEQ ID NO: 99 as being the pertinent prior art reference upon which this rejection was based.

However, upon obtaining and examining SEQ ID NO: 99, it was clear that there was some error, as this sequence is apparently one that exhibits some activity as a PDZ-binding kinase. A telephone call to Examiner Walicka pointed out this apparent discrepancy and requested a further investigation. The return voicemail message received was that there was indeed some mix-up in the nucleic acid sequences that are a part of this '662 patent and that she was apparently admitting that SEQ ID NO: 99 was not relevant. Accordingly, it is believed that it is clear that the rejection of the claims based upon SEQ ID NO: 99 of the Tang et al. patent is in error, and it is respectfully requested that this rejection be withdrawn.

In view of the foregoing amendments and remarks, it is believed that this application has now been placed in condition for allowance. Therefore, in the absence of more pertinent prior art, it is believed that the issuance of a Notice of Allowance is in order, and such action is courteously solicited.

Respectfully submitted,
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